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EXAMINER

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3626

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/391,335

Applicant(s)  
Joao

Examiner  
Alexander Kalinowski

Art Unit  
2166



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Sep 7, 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 20) ☐ Other:

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### **DETAILED ACTION**

1. Claims 1-20 are presented for examination.

#### ***Specification***

2. The disclosure is objected to because of the following informalities: the specification contains numerous grammatical and typographical errors. The errors are too numerous to list.

Some examples of errors include:

- a. On page 8, line 2, replace "to" with --of--;
- b. On page 8, line 11, after "various" delete "of"; and
- c. On page 17, line 21, after "intelligent" add --agent--.

Appropriate correction is required.

#### ***Claim Rejections - 35 U.S.C. § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, lines 1-2 and line 10, the phrase "employee benefits and employee benefits information" is unclear. How does an apparatus provide an employee benefit ? Does this

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mean an employee who successfully enrolls in a benefit plan? Or does this phrase mean the apparatus provides information regarding an employee benefit that an employee is enrolled in ? For purposes of applying prior art, the Examiner will interpret the phrase “employee benefits” as information regarding an employee benefit that an employee is enrolled in and employee benefits information as information describing employee benefits that the user is eligible to enroll in.

a. As per claims 2-9, the claims are dependent on claim 1 and are rejected based on their dependency to claim 1.

b. As per claim 10, lines 1-2 and lines 9-10, the phrase “employee benefits and employee benefits information” is unclear. How does an apparatus provide an employee benefit ? Does this mean an employee who successfully enrolls in a benefit plan? Or does this phrase mean the apparatus provides information regarding an employee benefit that an employee is enrolled in ? For purposes of applying prior art, the Examiner will interpret the phrase “employee benefits” as information regarding an employee benefit that an employee is enrolled in and employee benefits information as information describing employee benefits that the user is eligible to enroll in.

c. As per claims 11-19, the claims are dependent on claim 10 and are rejected based on their dependency to claim 10.

5. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 20, line 12, it is unclear which relationship the phrase “said relationship” refers

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to ? Is it the claimed "benefit provider relationship" or is it the claimed "independent relationship"? For purposes of applying prior art, the Examiner will interpret this limitation to be the claimed "independent relationship".

***Claim Rejections - 35 U.S.C. § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 1-7, 9-16, and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Warady et al, Pat. No. 6,067,522 (hereinafter Warady).

As per claim 1, Warady discloses an apparatus for providing employee benefits and/or employee benefits information (i.e. health and welfare benefits)(see Fig. 1 and abstract), which comprises:

a central processing device (i.e. unit 600)(Fig. 6);

a database for storing employee benefits one of data and information (i.e computerized database management system)(col. 4, lines 24-31); and

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a receiver for receiving a request for one of employee benefits and employee benefits information (i.e. health and welfare benefits enrollment and billing system unit 1, modem)(col. 8, lines 27-47 and col. 10, lines 42-48),

wherein said central processing device processes said request for one of employee benefits and employee benefits information in conjunction with said one of data and information stored in said database, and further wherein said central processing device generates a response to said request for one of employee benefits and employee benefits information (i.e. employee enrollment and confirmation of each employee's enrollment status)(col. 10, lines 55-63).

As per claim 2, Warady discloses the apparatus of claim 1, which further comprises:

a transmitter for transmitting said response to one of an employee, a benefits beneficiary, and a benefits administrator (i.e. communication between the user and the data entry and user interface module ... by modem ... confirmation may be generated to employee, employer and respective plan providers ... modem)(col. 8, lines 27-47 and col. 10, lines 55-67).

As per claim 3, Warady discloses the apparatus of claim 1, which further comprises:

a communication device, wherein said communication device transmits said request for one of employee benefits and employee benefits information (i.e. communication between the user and the data entry and user interface module ... by modem)(col. 8, lines 27-47).

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As per claim 4, Warady the apparatus of claim 3, wherein said communication device receives said response to said request for one of employee benefits and employee benefits information (i.e. communication between the user and the data entry and user interface module ... by modem)(col. 8, lines 27-47).

As per claim 5, Warady discloses the apparatus of claim 1, wherein said apparatus further comprises:

at least one of an employer computer system, a health insurance computer system, a disability insurance computer system, a life insurance computer system, a credit union/banking services computer system, a pension benefits computer system, a retirement benefits computer system, and an employee discount computer system (i.e. places, forms, reports, bills, and other outputs ... into a desired format for transmission to employees, employers, plan providers, and/or other third parties (e.g. payroll and human resource personnel and/or systems) ... modem)(col. 9, lines 23-32).

As per claim 6, Warady discloses the apparatus of claim 1, wherein said database comprises:

at least one of employer benefits information, health insurance information, disability insurance information, life insurance information, a credit union/banking services information, pension benefits information, retirement benefits information, and an employee discount benefits

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information (e.g., medical, dental, vision, life, disability, etc.)(Fig. 7a-7e and Fig. 8)(col. 9, lines 45-57 and line 59 - col. 8, line 22).

As per claim 7, Warady discloses the apparatus of claim 1, wherein said apparatus operates one of on, and over, a communication network (i.e. modem)(i.e. communication between the user and the data entry and user interface module ... by modem)(col. 8, lines 27-47.

As per claim 9, Warady discloses the apparatus of claim 3, wherein said communication device transmits at least one of a request for employee benefits, a request for employee benefits information, a claim for employee benefits, and a request for claim status (i.e. communication between the user and the data entry and user interface module ... by modem ... confirmation may be generated to employee, employer and respective plan providers ... modem)(col. 8, lines 27-47 and col. 10, lines 55-67).

As per claim 10, Warady discloses an apparatus for providing employee benefits and/or employee benefits information (i.e. health and welfare benefits)(see Fig. 1 and abstract), which comprises:

a central processing means (i.e. unit 600)(Fig. 6);

a means for storing employee benefits one of data and information(i.e computerized database management system)(col. 4, lines 24-31); and



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a means for receiving a request for one of employee benefits and employee benefits information (i.e. health and welfare benefits enrollment and billing system unit 1, modem)(col. 8, lines 27-47 and col. 10, lines 42-48),

wherein said central processing means processes said request for one of employee benefits and employee benefits information in conjunction with said one of data and information stored in said storage means, and further wherein said central processing means generates a response to said request for one of employee benefits and employee benefits information (i.e. employee enrollment and confirmation of each employee's enrollment status)(col. 10, lines 55-63).

As per claim 11, Warady discloses the apparatus of claim 10, which further comprises:

a means for transmitting said response to one of an employee, a benefits beneficiary, and a benefits administrator ( i.e. communication between the user and the data entry and user interface module ... by modem ... confirmation may be generated to employee, employer and respective plan providers ... modem)(col. 8, lines 27-47 and col. 10, lines 55-67).

As per claim 12, Warady discloses the apparatus of claim 10, which further comprises:

a communication means, wherein said communication means transmits said request for one of employee benefits and employee benefits information (i.e. communication between the user and the data entry and user interface module ... by modem)(col. 8, lines 27-47).

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As per claim 13, Warady discloses the apparatus of claim 12, wherein said communication means receives said response to said request for one of employee benefits and employee benefits information (i.e. communication between the user and the data entry and user interface module ... by modem)(col. 8, lines 27-47).

As per claim 14, Warady discloses the apparatus of claim 10, wherein said apparatus further comprises:

at least one of an employer computer system, a health insurance computer system, a disability insurance computer system, a life insurance computer system, a credit union/banking services computer system, a pension benefits computer system, a retirement benefits computer system, and an employee discount computer system (i.e. places, forms, reports, bills, and other outputs ... into a desired format for transmission to employees, employers, plan providers, and/or other third parties (e.g. payroll and human resource personnel and/or systems) ... modem)(col. 9, lines 23-32).

As per claim 15, Warady discloses the apparatus of claim 10, wherein said storage means comprises:

at least one of employer benefits information, health insurance information, disability insurance information, life insurance information, a credit union/banking services information, pension benefits information, retirement benefits information, and an employee discount benefits

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information (e.g., medical, dental, vision, life, disability, etc.)(Fig. 7a-7e and Fig. 8)(col. 9, lines 45-57 and line 59 - col. 8, line 22).

As per claim 16, Warady discloses the apparatus of claim 10, wherein said apparatus operates one of on, and over a communication network (i.e. modem)(i.e. communication between the user and the data entry and user interface module ... by modem)(col. 8, lines 27-47).

As per claim 18, Warady discloses the apparatus of claim 12, wherein said communication means transmits at least one of a request for employee benefits, a request for employee benefits information, a claim for employee benefits, and a request for claim status (i.e. communication between the user and the data entry and user interface module ... by modem ... confirmation may be generated to employee, employer and respective plan providers ... modem)(col. 8, lines 27-47 and col. 10, lines 55-67).

As per claim 19, Warady discloses a method for providing employee benefits and/or employee benefits information i.e. health and welfare benefits)(see Fig. 1 and abstract), which comprises:

receiving a request for one of employee benefits and employee benefits information i.e. communication between the user and the data entry and user interface module ... by modem)(col. 8, lines 27-47);

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processing said request in conjunction with employee benefit information (i.e. employee enrollment and confirmation of each employee's enrollment status)(col. 10, lines 55-63).; and

transmitting a response to said request for one of employee benefits and employee benefits information (i.e. employee enrollment and confirmation of each employee's enrollment status)(col. 10, lines 55-63)..

As per claim 20, Warady discloses a method for providing portable employee benefits (i.e. health and welfare benefits)(see Fig. 1 and abstract) comprising:

establishing a benefit provider relationship with a benefit beneficiary through an employer (i.e. health and welfare benefits)(see Fig. 1 and abstract);

establishing an independent relationship between the benefit provider and the benefit beneficiary independent of an employment relationship (i.e. employee terminated ... dependents covered by benefit plans other than employee's benefit plans)(col. 6, lines 54-61 and col. 7, lines 37-50) ; and

providing an opportunity for the benefit provider and the benefit beneficiary to continue said relationship independently of any employment relationship (i.e. dependents covered by benefit plans other than employee's benefit plans)( col. 7, lines 37-50).

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warady as applied to claim 7 above, and further in view of "Edify Broadens Application Suite in new Release of Employee Service System" (hereinafter Edify).

As per claim 8, Warady does not explicitly disclose the apparatus of claim 7, wherein said network is one of the Internet and the World Wide Web.

However, Edify discloses wherein said network is one of the Internet and the World Wide Web (i.e. select among health and welfare benefits ... using Web access ...)(see abstract, page 1). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein said network is one of the Internet and the World Wide Web as disclosed by Edify within the Warady system for the motivation of providing employees with anytime, anywhere access to benefits information (i.e. human resources services and resources)(abstract).

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warady as applied to claim 10 above, and further in view of Edify.

As per claim 17, Warady does not explicitly disclose the apparatus of claim 16, wherein said network is one of the Internet and the World Wide Web.

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However, Edify discloses wherein said network is one of the Internet and the World Wide Web (i.e. select health and welfare benefits ... using Web access)(see abstract, page 1). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein said network is one of the Internet and the World Wide Web as disclosed by Edify within the Warady system for the motivation of providing employees with anytime, anywhere access to benefits information (i.e. human resources services and resources)(abstract).

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Pat. No. 5,913,198 discloses a computer based system for implementing self funded survivor benefit plans.

b. Pat. No. 5,191,522 discloses a system for supervising a plurality of group insurance accounts.

c. WO 99/05626 A1 discloses a system for permitting employee participants to access independent

d. "Employeease Opens Four New Offices" discloses an Internet powered service for administering human resources and employee benefits.

e. "Extranets: The latest developments" discloses companies using the Internet to access and post data.

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f. "Managing health benefits: The birth of the on-line page" discloses on-line systems that permit employees access to health benefits information.

g. "A low-cost alternative to the traditional HRIS" discloses a browser based system that provides employee benefits information.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 8:30 AM to 6:00 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-0040.

Alexander Kalinowski *AK*

4/17/2002

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